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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/597,630

08/02/2006

Kin Fai Kam

KAM 0101 PUSA

4213

22045 7590 08/11/2009

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EXAMINER

CLINE, SALLY COLSON

ART UNIT

PAPER NUMBER

3765

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,630	<b>Applicant(s)</b> KAM, KIN FAI	
	<b>Examiner</b> Sally Colson Cline	<b>Art Unit</b> 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment, filed 07 May 2009, has been reviewed and considered. Claims 1-13 and 15-16 are amended and claims 19-20 are new, leaving claims 1-20 pending. This Office Action is considered a final rejection.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Objections***

3. Claim 17 is objected to because of the following informalities: the status identifier should read –Original—and not “previously presented.” Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter is “supported directly on a wearer's head,” “support members,” and “the support members are configured to

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reduce a force directly exerted on the wearer by the spectacles.” Claims 2-20 depend from rejected claim 1.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding the limitation that “the support members are configured to reduce a force directly exerted on the wearer by the spectacles,” how and by what means is this accomplished? Claims 2-20 depend from rejected claim 1.

8. Claim 2 recites the limitation “the rods” in line 2. There is insufficient antecedent basis for this limitation in the claim. For the purpose of examination, “the rods” will be treated as --support members--.

9. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It appears from the sentence structure that “the ends” are “wearing the headwear.” Additionally, if the headwear is being worn, how is it simultaneously “not in use?” What element is “not in use?” Is it the headwear, the ends, the support members, or the projecting portion?

10. Claims 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It appears from the sentence structure that “the

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support members" are "wearing the headwear." Additionally, if the headwear is being worn, how is it simultaneously "not in use?"

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Ferrara (USPN 7,013,491).

12. As to claim 1, Ferrara discloses headwear (1) to be supported directly on a wearer's head with a portion that projects beyond the circumference of the head above the eyes (2), support members (4) connected to the projecting portion (2) and having means at each free end (14) for detachable connection to the temple arms (3) of a pair of spectacles. The support members are configured to reduce a force directly exerted on the wearer by the spectacles, as best understood by the disclosure.

13. Claims 1-2, 7-12, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kiefer (USPN 3,089,145).

As to claim 1, Kiefer discloses headwear (6) to be supported directly on a wearer's head with a portion that projects beyond the circumference of the head above the eyes (fig 1), support members (7) connected to the projecting portion (fig 1) and having means at each free end (10) for detachable connection (column 2 line 4-6) to the temple arms (11) of a pair of spectacles. The support members are configured to

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reduce a force directly exerted on the wearer by the spectacles, as best understood by the disclosure.

As to claims 2 and 12, Kiefer discloses the support members are a spring material (col 2 line 9-21), which is a known flexible material. Furthermore, any flexible material is capable of being formed into a hook.

As to claim 7, Kiefer discloses the support members are permanent or detachable.

As to claim 8, Kiefer discloses the ends **can be** folded, because the support members are a spring material (col 2 line 9-21), and spring material inherently has bending properties. The support members are **capable** of being folded upwardly against the projection portion when not in use, as best understood by the disclosure.

As to claim 9, Kiefer discloses the support members are a single piece attached to the projecting portion and having free ends.

As to claim 10, Kiefer discloses the support members are two separate elements (7, 8).

As to claim 11, Kiefer discloses a hook (10).

As to claim 17-18, Kiefer discloses the headwear is a brim or visor.

As to claims 19-20, Kiefer discloses the support members are rods or strings.

### ***Claim Rejections - 35 USC § 103***

14. Claims 3-6 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiefer.

As to claims 3-5, Kiefer discloses the claimed invention except for adjustability. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made any element of the invention of Kiefer adjustable, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

As to claim 6, Kiefer discloses the invention substantially as claimed, including a plurality of holes (8) in the projecting portion through which the support members can pass. However, Kiefer does not expressly disclose a greater number of holes than support members. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided additional holes, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Furthermore, it is noted that the projecting portion of Kiefer has 4 holes and 4 support members, though only 2 holes and 2 support members are required to hold the projection portion in place, as can be inferred from figure 2. Therefore, it would have been obvious to have provided 4 of the holes with 2 of the support members so that the wearer might selectively choose from where to suspend the support members in order to vary the weight distribution.

As to claims 13-15, Kiefer discloses the invention substantially as claimed, but does not expressly disclose magnets. It is well known in the art that various types of fastening mechanisms are functionally equivalent. Hooks, snaps, magnets, and adhesive are a few examples. These fasteners may be used interchangeably

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depending upon the desired aesthetic effect. Furthermore, the specification does not give an indication of why the magnets would be desirable over another fastener type.

15. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kiefer in view of Schrack (USPN 4,768,231).

As to claim 16, Kiefer discloses the invention substantially as claimed, but does not expressly disclose catch elements. Schrack teaches a similar invention, including catch elements (17, 19) holding support members (16, 18) out of the way when not in use. The provision of both the support members and the catch elements in the projecting portion of the headwear represents a minor design variation that the skilled person would consider without the exercise of inventive skill. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Kiefer with the catch elements and support members of Schrack for the purpose of attaching eyewear and fastening the support members so that they do not block the vision of the wearer.

### ***Response to Arguments***

16. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sally Colson Cline whose telephone number is (571)272-6731. The examiner can normally be reached on M - F, 9AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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